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09/878,581	06/11/2001	Susumu Nakagawa	450100-03278	2762

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745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER
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SHELEHEDA, JAMES R

ART UNIT	PAPER NUMBER
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2623

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07/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/878,581	<b>Applicant(s)</b> NAKAGAWA, SUSUMU	
	<b>Examiner</b> JAMES SHELEHEDA	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22, 28-30 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) 10-17, 19, 21, 22, 29, 30 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 18, 20, 28 and 32-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group I in the reply filed on 06/20/08 is acknowledged. The traversal is on the ground(s) that the restriction requirement was made after-final and that there is no serious burden as all of the claims were previously present and examined.

This is not found persuasive because the restriction is in response to applicant's claim amendments filed 02/19/08 which were made after a non-final rejection.

These amendments added claim limitations which were never previously examined or rejected. Specifically, Group I, claims 1-9, 18, 20, 28 and 32-36, was amended to include limitations specifically directed to inserting targeted advertisements during transmission of video content. Group II, claims 10-17, 19, 22, 30 and 37, was amended to include limitations specifically directed to providing image content *in its entirety* and then inserting targeting advertisements during reproduction of the image content. Group III, claims 21 and 29, were amended to include limitations of an advertisement logging system which would receive information from both an image providing apparatus and an image reproduction apparatus.

Thus, the restriction is based upon *applicant's most recent claim amendments*, which separated the claims into distinctly separate groups of subcombinations.

Therefore, applicant's arguments are not convincing, as the claims in their current form, were never previously examined and rejected.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 36 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 36 recites distributing image content image content wherein “(a) the image program providing apparatus provides the image and advertisement image directly to said image program reproducing apparatus, (b) the image program providing apparatus instructs a plurality of deputy image program providing apparatuses to distribute the image with the inserted advertisement image to said image program reproducing apparatus **and** (c) the image program providing apparatus distributes the image to a plurality of distribution splitter nodes and the splitter nodes acquire the advertisement image and distribute the image and advertisement image to said image program reproducing apparatus” which is not supported by the specification as originally filed.

More specifically, the specification discloses *alternative* distribution methods wherein the system may provide the image to the reproducing apparatus:

- (a) directly; or
- (b) via a plurality of deputy image providing apparatuses; or
- (c) via a plurality of distribution splitter nodes.

There is no specific support for distributing the image content to the same reproduction apparatus via all three distribution methods.

To advance prosecution, in claim 36, lines 24-25, “and (c)” is being interpreted as “or (c)”.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-9, 18, 32, 34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Bar-el (WO 99/26415 A1).

As to claim 1, Bar-el discloses an image content providing method of providing an image content via stream distribution from an image content providing apparatus to an image content reproducing apparatus (page 7, lines 2-19), said image content providing method comprising the steps of:

requesting, via the stream distribution, distribution of said image content from said image content reproducing apparatus to said image content providing apparatus (page 7, lines 20-22);

transmitting, via stream distribution, said image content to said image content reproducing apparatus (Fig. 1; page 8, lines 4-18) and during transmission detecting a position of inserting an advertisement image in said image content at said image content providing apparatus (page 14, line 14-page 15, line 5);

requesting an advertisement image providing apparatus having said advertisement image to distribute said advertisement image to said image content providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

selecting said advertisement image to be inserted into said image content (page 11, line 14-page 12, line 9) and transmitting thereof to said image content providing apparatus at said advertisement image providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

inserting said advertisement image transmitted to said image content providing apparatus at the position of inserting said advertisement image when into said image content at said image content providing apparatus (page 14, line 24-page 16, line 21);  
and

distributing, via stream distribution, said image content with the inserted advertisement image from said image content providing apparatus to said image content reproducing apparatus (Fig. 1-2; page 7, line 11-page 8, line 18).

As to claim 3, Bar-el discloses wherein the position of said image content for inserting said advertisement image is detected based on advertisement inserting condition data having an advertisement image inserting position condition for

designating the position of inserting said advertisement image and an advertisement image selecting condition for designating a category of said advertisement image capable of being inserted to said image content (column 14, lines 14-21 and column 11, lines 14-19).

As to claim 4, Bar-el discloses wherein said advertisement inserting condition data includes an advertisement image reproducing condition for designating a maximum period of time for reproducing said advertisement image when said advertisement image is inserted to said image content (page 14, lines 14-21).

As to claim 5, Bar-el discloses wherein when said advertisement image is requested to distribute at said image content providing apparatus, said advertisement inserting condition data is transmitted to said advertisement image providing apparatus (page 11, lines 9-19) and when said advertisement image is selected at said advertisement image providing apparatus, said advertisement image is selected based on said advertisement inserting condition data (page 11, lines 9-19).

As to claim 6, Bar-el discloses wherein when said image content is requested to distribute at said image content reproducing apparatus, viewer information of a viewer for utilizing said image content is transmitted to said image content providing apparatus (page 10, lines 3-20).

As to claim 7, Bar-el discloses wherein when said advertisement image is requested to distribute at said image content providing apparatus, said viewer information is transmitted to said advertisement image providing apparatus (page 11, lines 6-19) and when said advertisement image is selected at said advertisement image providing apparatus, said advertisement image is selected based on said viewer information (page 11, lines 6-19).

As to claim 8, Bar-el discloses wherein said image content providing apparatus comprises:

- a main image content distributing apparatus (Fig. 1-2); and
- a plurality of deputy image content distributing apparatus (page 7, lines 13-19);

wherein said main image content distributing apparatus selects one of the deputy image content distributing apparatus from said plurality of deputy image content distributing apparatus by a request of distributing said image content from said image content reproducing apparatus and said selected deputy image content distributing apparatus distributes said image content to said image content reproducing apparatus (plurality of intermediate routers and nodes present in an Internet distribution system; page 7, lines 13-19 and page 10, line 23-page 11, line 5).

As to claim 9, Bar-el discloses wherein said image content providing apparatus comprises:

- a main image content distributing apparatus (Fig. 1-2); and



a plurality of image content distribution splitter nodes (page 7, lines 13-19).;

wherein when said main image content distributing apparatus is requested to distribute said image content, said main image content distributing apparatus selects said image content distribution splitter node and distributes said image content to said image content distribution splitter node and said image content is distributed from said image content distribution splitter node to said image content reproducing apparatus (plurality of intermediate routers and nodes present in an Internet distribution system; page 7, lines 13-19 and page 10, line 23-page 11, line 5).

As to claim 18, Bar-el discloses image content providing system (page 7, lines 2-19), comprising:

an image content providing apparatus having an image content and having a function of providing said image content via stream distribution (Fig. 1; page 8, lines 4-18);

an advertisement image providing apparatus having an advertisement image to be inserted to said image content and having a function of providing said advertisement image via stream distribution to said image content providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

an image content reproducing apparatus having a function of reproducing said image content and said advertisement image received from said image content providing apparatus (page 8, lines 15-18);

wherein said image content providing apparatus has a function of inserting the advertisement image transmitted via stream distribution from said advertisement image providing apparatus into said image content (page 14, line 24-page 16, line 21) and providing via stream distribution said image content and said advertisement image to said image content reproducing apparatus (Fig. 1-2; page 7, line 11-page 8, line 18).

As to claims 32 and 34, Bar-el discloses wherein said image content is a moving picture (page 8, lines 11-18).

As to claim 36, Bar-el discloses an image providing method of providing an image from an image program providing apparatus to an image program reproducing apparatus (page 7, lines 2-19), said image providing method comprising the steps of:

requesting, via the stream distribution, distribution of said image from said image program reproducing apparatus to said image content program providing apparatus (page 7, lines 20-22);

transmitting, via stream distribution, said image to said image program reproducing apparatus (Fig. 1; page 8, lines 4-18) and during transmission detecting a position of inserting an advertisement image in said image at said image program providing apparatus (page 14, line 14-page 15, line 5);

requesting an advertisement image providing apparatus having said advertisement image to distribute said advertisement image to said image program providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

selecting said advertisement image to be inserted into said image (page 11, line 14-page 12, line 9) and transmitting thereof to said image program providing apparatus at said advertisement image providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

inserting said advertisement image transmitted to said image program providing apparatus into said image (page 14, line 24-page 16, line 21); and

distributing, via stream distribution, said image content with the inserted advertisement image, wherein the image program providing apparatus instructs a plurality of deputy image program providing apparatuses to distribute the image with the inserted advertisement image to said program reproducing apparatus (plurality of intermediate routers and nodes present in an Internet distribution system; page 7, lines 13-19 and page 10, line 23-page 11, line 5).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 20, 28, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-el.

As to claims 33 and 35, while Bar-el discloses wherein said image content is video, he fails to specifically disclose wherein said video content is one of a movie, a drama and an animation.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide movies, dramas and an animation, which were all well known and popular forms of video, for the typical benefit of providing viewers with the respective form of video content, such as a movie, drama or animation, that they desire.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include wherein said video content is one of a movie, a drama and an animation for the typical benefit of providing viewers with the respective form of video content, such as a movie, drama or animation, that they desire, in an interactive video distribution system.

As to claim 2, while Bar-el discloses wherein when said image content is requested to distribute at said image content reproducing apparatus, said image content is selected and requested to distribute based on information for viewing said distributable image contents to be transmitted from said image content providing apparatus (page 7, line 20), he fails to specifically disclose a title list.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide a title list, listing the available videos for selection, for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include a title list for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

As to claim 20, while Bar-el discloses an image content providing apparatus for providing an image content via stream distribution (Fig. 1; page 8, lines 4-18), said image content providing apparatus comprising:

an image content database for storing said image content (Fig. 2; page 11, lines 20-23);

image providing means having a function of receiving an advertisement image via stream distribution (page 12, lines 3-9 and page 14, line 22-page 15, line 5), inserting the advertisement image into said image content of said image database (page 14, line 24-page 16, line 21) and distributing thereof via stream distribution (Fig. 1-2; page 7, line 11-page 8, line 18), and

means having a function of forming information of viewing said image content stored to said image content database and providing said title list (means for user selection of an available video; page 11, lines 20-21), he fails to specifically disclose a title list.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide a title list, listing the available videos for selection, for

the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include a title list for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

As to claim 28, while Bar-el discloses a program storage medium stored with an image content providing program which is a program storage medium stored with an image content providing program for providing an image content (Fig. 2; page 11, lines 20-23), said program storage medium comprising:

image providing means having a function of receiving an advertisement image via stream distribution (page 12, lines 3-9 and page 14, line 22-page 15, line 5), inserting the advertisement image into said image content of said image database (page 14, line 24-page 16, line 21) and distributing thereof via stream distribution (Fig. 1-2; page 7, line 11-page 8, line 18),

means having a function of forming information of viewing said image content stored to said image content database and providing said title list (means for user selection of an available video; page 11, lines 20-21), he fails to specifically disclose a title list.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide a title list, listing the available videos for selection, for

the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include a title list for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information

Application/Control Number:  
09/878,581  
Art Unit: 2623

Page 15

and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

## Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is



(571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Sheleheda  
Examiner, Art Unit 2623

JS  
/Chris Kelley/  
Supervisory Patent Examiner, Art Unit 2623